



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/561,969

04/10/2006

Kwai Ming Cheung

010180.00047

1639

22907 7590 05/30/2008

BANNER & WITCOFF, LTD.

1100 13th STREET, N.W.

SUITE 1200

WASHINGTON, DC 20005-4051

EXAMINER

CHU, YONG LIANG

ART UNIT

PAPER NUMBER

1626

MAIL DATE

DELIVERY MODE

05/30/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/561,969	Applicant(s) CHEUNG ET AL.	
	Examiner YONG CHU	Art Unit 1626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 8-23 and 25 is/are pending in the application.
- 4a) Of the above claim(s) 11-14 and 17-23 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 8-10, 15, 16 and 25 is/are rejected.
- 7) ☒ Claim(s) 1, 8-10, 15, 16 and 25 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 2-7 and 24 have been canceled by the amendment on 02/14/2008.

Claims 1, 8-23 and 25 are pending. Claims 11-14 and 17-23 remain withdrawn as non-elected subject matter. Claims 1, 8-10, 15-16 and 25 will be examined on the merits.

Response to Amendment

The amendment by Applicants' representative Susan A. Wolffe dated on 02/14/2008 has been entered.

Response to Arguments/Remarks

Rejection under 35 U.S.C. §112, 2nd paragraph

Applicant's amendment of claims 1-4, 6-10, 15-16, and 25 obviates the rejection. However, the amendment of definition **R** in claim 1 is not fully supported by the specification.

Rejection under 35 U.S.C. §102(b)

Applicant's amendment of claim 1 obviated the rejection of claims 1-4, 6-10, 15-16, and 25.

Claim Objections

The objected claims still contain the non-elected subject matter. Therefore, the objection is maintained.

Since the amendment has overcome the cited art rejection, the Examiner has expanded the search to part of the previously non-elected subject matter, and new prior art anticipates the expanded scope of subject matter as disclosed follow:

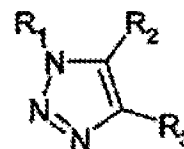
Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8-10, 15-16 and 25 are rejected under 35 U.S.C. 102 (b) as being anticipated by Medaer et al., *Tetrahedron*, 1997, 52(26), pp.8813-8826 ("Medaer et al.").



Applicants' claims relate to a compound of the Formula (IE)

wherein:

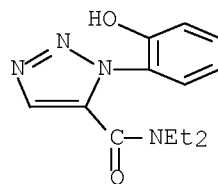
R¹ is $-\text{Ar}^1-(\text{Alk}^1)_s-(\text{Z})-(\text{Alk}^2)_p-\text{Q}$, wherein **Ar¹** is an optionally substituted phenol, **s**= **r**= **p**= 0,

and **Q** is a hydrogen;

R² is a carboxamide radical;

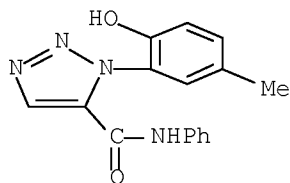
R³ is hydrogen, in claim 1.

Medaer et al. disclosed the compounds



(CAS RN 160921-51-

7), and



(CAS RN 180859-14-7). These compounds anticipated

the instant claims 1-4, 6, 15-16, and 25, wherein R^1 is $-Ar^1-(Alk^1)_s-(Z)_r-(Alk^2)_p-Q$, wherein Ar^1 is an optionally substituted phenol, $s=r=p=0$, and Q is a hydrogen; R^2 is a carboxamide radical; and R^3 is hydrogen.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

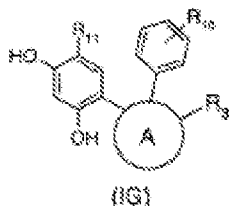
The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 6, 15-16, and 25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Specifically, the

amended claim 1, **R** is further defined as

R represents hydrogen or one or more substituents selected from (C₁-C₆)alkyl, (C₁-C₆)alkoxy, hydroxy, hydroxy(C₁-C₆)alkyl, mercapto, mercapto(C₁-C₆)alkyl, (C₁-C₆)alkylthio, halo (including fluoro and chloro), trifluoromethyl, trifluoromethoxy, nitro, nitrile (-CN), oxo, phenyl, -COOH, -COOR^A, -COR^A, -SO₂R^A, -CONH₂, -SO₂NH₂, -CONHR^A, -SO₂NHR^A, -CONR^AR^B, -SO₂NR^AR^B, -NH₂, -NHR^A, -NR^AR^B, -OCONH₂, -OCONHR^A, -OCONR^AR^B, -NHCOR^A, -NHCOOR^A, -NR^BCOOR^A, -NH₂SO₂OR^A, -NR^BSO₂OR^A, -NHCONH₂, -NR^ACONH₂, -NHCONHR^B, -NR^ACONHR^B, -NHCONR^AR^B or -NR^ACONR^AR^B wherein R^A and R^B are independently a (C₁-C₆)alkyl group.

The support for **R** in the specification can be found at page 16 as **R¹¹**



- wherein R₉ represents a carboxamide group (especially an ethylcarboxamide group CH₃CH₂NHC(=O)-), R₁₀ represents C₁-C₆ alkoxy such as methoxy or ethoxy, fluoro, chloro, bromo, morpholinomethyl, piperazino, N-methylpiperazino, piperidino, N-methylpiperazinomethyl, or piperidinomethyl, and R₁₁ represents bromo, chloro, phenyl, C₁-C₆ alkyl such as ethyl, isopropyl, isobutyl or tert-butyl, or phenyl(C₁-C₆ alkyl)- such as benzyl or phenylethyl.

There is not enough support in the original specification commensurate in the scope of the amended claims. To overcome the rejection, applicants need to show the support in the original disclosure for such amendment, or amend the claims with full support from the original specification.

Conclusions

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Status Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Yong Chu, Ph.D./
Patent Examiner
Art Unit 1626

/Kamal Saeed, Ph.D./
Primary Patent Examiner
Art Unit 1626